

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES***

Applicant: Lautenbacher, Markus  
Title: SERVICE SYSTEM FOR AN IP-BASED  
COMMUNICATION NETWORK  
Appl. No.: 09/868,277  
International Filing Date: 12/14/1999  
371(c) Date: 06/15/2001  
Examiner: Nawaz, Asad M.  
Art Unit: 2155  
Confirmation No.: 7143

**REPLY BRIEF**

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Commissioner for Patents  
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Sir:

Under the provisions of 37 C.F.R. § 41.41, this Reply Brief is being filed in response to the Examiner's Answer dated April 30, 2008.

## **ARGUMENT**

### **I. Claim Rejections under 35 U.S.C. § 112**

On page 3 of the Examiner's Answer, the Examiner states that Claims 16-20, 24-26 and 30-31 were rejected under 35 U.S.C. 112, first paragraph, because the "limitation of interworking programs with applications on at least one other terminal is not found in the specification."

On page 6 of the Examiner's Response, the Examiner maintains the rejection stating that:

none of the cited portions teach the limitation appearing in each independent claim directed towards "downloadable programs configured to interwork with the application programs on at least one other terminal of the network for realizing user services."

Independent Claim 16 recites:

at least one server storing application programs for implementing user specific subscribable services, said server storing said services on a per user basis;

and

at least one terminal coupled to the server and having on-demand access to said IP-based network for requesting downloadable programs corresponding to said services, whereby said application programs can be executed, said downloadable programs configured to interwork with the application programs on at least one other terminal of the network for realizing user services

Independent Claim 24 recites:

In an IP network, a terminal comprising a client component for on-demand requesting of user downloadable application software from a server, said application software is configured to interwork with the application software on at least one other terminal of the network for realizing user services, and is capable of implementing user subscribable services.

The server in Claim 16 stores "application programs for implementing user specific subscribable services ... on a per user basis". (See, e.g., specification paragraphs 8, 12-15, 22, 26-28, 30, 41-43, 45-48, 50-52, 56, and 73-74). Each individual user subscribes to certain

services from a group of available services. (See, e.g., specification paragraphs 8, 15, 26-28, 30, 41, 45-47, 50-51, 53). Each of these services corresponds to one or more application programs stored on the server. (See, e.g., specification paragraphs 12, 15, 26, 41-43, 45-47, 50-52, 55-56; and Figure 3). To implement the subscribed services, the application programs corresponding to the subscribed services are downloaded by the user. (See, e.g., specification paragraphs 15, 26, 28, 30, 46, 52-53, 56, 59, 73). The downloaded application programs, when executed, are configured to implement the subscribed service. (See, e.g., specification paragraphs 13-14, 28, 38, 41-43, 46, 53-54, 59, 73).

Claim 16 further comprises “at least one terminal [such as a PC or a PDA] coupled to the server and having on-demand access to said IP-based network for requesting downloadable programs corresponding to said services”. (See, e.g., specification paragraphs 7, 9, 11, 15, 26, 30, 38, 40, 44, 46-47, 49, 52-53, 56, 59). A terminal, such as a PC, laptop, PDA or other type of mobile device, that can access the IP-based network will have on-demand access to the downloadable programs for implementing the subscribed to services. (See, e.g., specification paragraphs 15, 46, 73). The downloadable programs are the stored application programs corresponding to services the user has subscribed to. (See, e.g., specification paragraphs 26, 28, 30, 45-48, 51-53). With respect to the user, the stored application programs include the programs that are downloadable and the programs are not downloadable. (See, e.g., specification paragraphs 46, 49-52 and 73; Figures 2-4). The programs that are not downloadable correspond to services the user has not subscribed to. (See, e.g., specification paragraphs 26, 28, 30, 45-48, 51-53). The downloadable programs are downloaded to the user terminal and executed by the user to provide the subscribed to services. (See, e.g., specification paragraphs 12-15, 26, 28, 30, 45-48, 51-53, 56, 73). In this way, the application programs from the server may be executed on various terminals (“whereby said application programs can be executed”). (See, e.g., specification paragraphs 7, 10-11, 19, 38, 55-56 and 73).

Claim 16 further comprises “said downloadable programs configured to interwork with the application programs on at least one other terminal of the network for realizing user services”. (See, e.g., specification paragraphs 7-10, 13, 15, 19, 26, 28, 30, 45-53 and 56; Figures 2-5). There is an interworking relationship between the application programs stored

on the server and the downloadable programs (downloadable programs are the stored application programs that correspond to the services subscribed to by the user; whereas the remaining stored application programs are not downloadable because they correspond to services not subscribed to by the user). (See, e.g., specification paragraphs 8, 13, 15, 26, 28, 30, 45-53; Figures 2-4). It is an interworking relationship because anytime the user initiates accesses to the IP-based network from a terminal on the network, such as a PC, laptop, PDA or other mobile device with network capabilities, the downloadable programs corresponding to the subscribed to services are drawn from the pool of stored application programs and downloaded to the PC, laptop, PDA or other type of mobile device capable of connecting to the network. (See, e.g., specification paragraphs 7-10, 13, 15, 19, 26, 28, 30, 45-53 and 56; Figures 2-5). This interworking relationship allows the user to migrate from one terminal on the network to another while maintaining the same subscribed to services provided by the execution of the downloadable programs. (See, e.g., specification paragraphs 7-10, 13, 15, 19, 26, 28, 30, 45-53 and 56; Figures 2-5).

Also pertinent to the interworking relationship between the stored application programs and downloadable programs is that the set of downloadable programs for a particular user may change. (See, e.g., specification paragraphs 47-56). The change may be the result of a user choosing to subscribe to more or fewer services. (See, e.g., specification paragraphs 47-48, 50-52). If the user subscribes to more services, more application programs will be required to provide the subscribed to services. If the user unsubscribes from services, fewer application programs will be required to provide the subscribed to services. Therefore, changes in user subscription alters the relationship between the downloadable programs for that particular user and the program applications stored on the server. Furthermore, the stored application programs corresponding to services may change to add new services or upgrade currently available service. (See, e.g., specification paragraphs 54-56).

Thus, the downloadable programs interwork with application programs on one or more terminals on the network because the downloadable programs are drawn from the pool of stored application programs for implementation on the one or more terminals and the programs downloadable by the user may change through changes in the user's subscription or upgrades/alterations to the stored application programs.

The same arguments and explanations apply to independent Claim 24. Applicant respectfully submits that the specification, as evidenced above, describes an interworking relationship between the downloadable programs and the application programs on one or more terminals in the network for realizing user services as described in Claims 16 and 24. Claims 17-20 depend from Claim 16 and are allowable for at least the same reasons as Claim 16. Claims 25-26 and 30-31 depend from Claim 24 and are allowable for at least the same reasons as Claim 24.

On page 7-8 of the Examiner's Answer, in support of the Examiner's rejection under 35 U.S.C. 112, the Examiner maintains that:

The claim language states that the steps can interwork/execute/process on a terminal of the network. This is opposite of and in direct contradiction to appellant's specification (0057-0074) and arguments (see brief page 9) that states that the terminal is not a network entity. The examiner points out that this aspect of the claim language is not well disclosed, if at all, in the specification.

Applicant respectfully disagrees with the Examiner's statement regarding the Applicant's characterization of the terminal as a not being a network entity in contradiction to the language of the claims. Page 9 of Applicant's Appeal Brief states that applications are running on an intelligent terminal and "not in some sort of central network entity". This statement does not mean that the intelligent terminal is not a network entity, rather that the intelligent terminal is not a central or core network entity, such as a server. The specification describes the intelligent terminals as edge equipment of the network rather than the core of the network. (See, e.g., specification paragraphs 12-15). As clearly described in the specification, claims and Applicant's Appeal Brief, the application programs are downloaded to the intelligent terminal on the network from the central network entity (e.g., the server) and executed locally on the intelligent terminal. (See, e.g., specification paragraphs 12-15).

Accordingly, Applicant respectfully submits that the claims of the present application do not contradict Applicant's specification or Appeal Brief.

Accordingly, Applicant respectfully requests that Claims 16-20, 24-26 and 30-31 be found to meet the requirements of 35 U.S.C. § 112, first paragraph.

## II. Claim Rejections under 35 U.S.C. § 102

On pages 3-4 of the Examiner's Answer, the Examiner states that Claims 16-20 and 24-26 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,757,729 ("Devarakonda").

With respect to independent Claims 16 and 24, the Examiner stated that:

Devarakonda teaches In and IP-based network, a system comprising: at least one server storing application programs for implementing user specific subscribable services, said server storing said services on a per user basis; (Abstract; Fig. 1; col 1, 28-40; col 3, 50-56; col 4, 38-40)

And at least one terminal coupled to the server and having on-demand access to said IP-based network for requesting downloadable programs corresponding to said services, whereby said application programs can be executed, said downloadable programs configured to network with the application programs on at least one other terminal of the network for realizing user services. (Fig 1; col 4, 43-44; col 6, 4-8)

On page 8 of the Examiner's Answer, the Examiner further maintains that:

The claim language contains terminology such as "configured to" and whereby clauses. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The Examiner has not provided support for this conclusion relating to structural differences. MPEP §2111.04 does not make mention of the limitation "configured to."

MPEP § 2111.04 states, in part:

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

(A) "adapted to" or "adapted for" clauses;

(B) "wherein" clauses; and

(C)“whereby” clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case.

The Examiner does not explain why use of the limitation “configured to” fails to limit a claim to a particular structure. Claim 16 recites “said downloadable programs configured to interwork with the application programs on at least one other terminal of the network for realizing user services.” Thus, the particular structure defined in this limitation is the downloadable programs.

Furthermore, in Claim 16 the recited server stores “application programs for implementing user specific subscribable services ... on a per user basis”. As such, the claimed server stores, not just any type of application program, but programs that implement user specific subscribable services on a per user basis. Also, Claim 16 provides for a terminal that requests the downloadable programs corresponding to the subscribed to services. Thus, the invention defined by Claim 16 is very different from that found in the Devarakonda.

Devarakonda is directed to a VEM (Virtual Environment Manager) for providing access to network services whereby “the VEM queries a Service Directory Table available on one or more connected servers. The access to the Service Directory Table returns a handle, which is used to connect to the indicated service provider.” (See Devarakonda at col. 1, lines 49-54). The handle is used by the client computer to implement services, such as printing, on the service provider (e.g., a print server). (See Devarakonda at col. 4, lines 14-19 and 65-67).

Claim 16 is in independent form and recites, in combination with other elements, “at least one server storing application programs for implementing user specific subscribable services ... at least one terminal coupled to the server and having on-demand access to said IP-based network for requesting downloadable programs corresponding to said services, whereby said application programs can be executed, said downloadable programs configured to interwork with the application programs on at least one other terminal of the network for realizing user services.” Claims 17-20 depend from independent Claim 16.

Devarakonda does not identically disclose a “at least one **server storing application programs for implementing user specific subscribable services** ... at least one terminal coupled to the server and having on-demand access to said IP-based network for **requesting downloadable programs corresponding to said services, whereby said application programs can be executed, said downloadable programs configured to interwork with the application programs on at least one other terminal of the network for realizing user services**” as recited in independent Claim 16. The server in Devarakonda stores lists of services available to the network, the location of the service provider on the network and a handle to access the service provider. (See Devarakonda at col. 4, lines 14-19 and 65-67). This is not the same as “at least one server storing application programs for implementing user specific subscribable services” as recited in Claim 16. Furthermore, the terminal in Devarakonda does not “request downloadable programs corresponding to said services” where the downloadable programs are “configured to interwork with the application programs on at least one other terminal of the network for realizing user services” as recited in Claim 16.

Thus, the rejection of Claim 16 over Devarakonda is improper. Claim 16 is patentable over Devarakonda.

Dependent Claims 17-20, which depend from independent Claim 16, are also patentable for at least the same reasons as Claim 16.

Claim 24 is in independent form and recites, in combination with other elements, “a terminal comprising a client component for on-demand requesting of user downloadable application software from a server, said application software is configured to interwork with the application software on at least one other terminal of the network for realizing user services, and is capable of implementing user subscribable services.” Claims 25-26 depend from independent Claim 24.

Devarakonda does not identically disclose a “a terminal comprising a client component for on-demand requesting of **user downloadable application software from a server, said application software is configured to interwork with the application**



**software on at least one other terminal of the network for realizing user services**, and is capable of implementing user subscribable services” as recited in independent Claim 24. The terminal in Devarakonda submits a request to use a service provided by a service provider on the network. The server in Devarakonda stores lists of services available to the network, the location of the service provider on the network and a handle to access the service provider. (See Devarakonda at col. 4, lines 14-19 and 65-67). This is not the same as “a terminal comprising a client component for on-demand requesting of user downloadable application software from a server” as recited in Claim 24. Furthermore, the terminal in Devarakonda does not “request downloadable programs corresponding to said services” where the downloadable programs are “configured to interwork with the application programs on at least one other terminal of the network for realizing user services” as recited in Claim 24.

Thus, the rejection of Claim 24 over Devarakonda is improper. Claim 24 is patentable over Devarakonda.

Dependent Claims 25-26, which depend from independent Claim 24, are also patentable for at least the same reasons as Claim 24.

Applicant respectfully requests withdrawal of the rejection of Claims 16-20 and 24-26 under 35 U.S.C. § 102(e).

### **III. Claim Rejections under 35 U.S.C. § 103**

On page 5 of the Examiner’s Answer, the Examiner states that Claims 30-31 were rejected under 35 U.S.C. 103(a) as being anticipated by Devarakonda further in view of U.S. Patent No. 5,365,606 (“Brocker”).

Claims 30-31 depend from independent Claim 24 and are allowable over Devarakonda for at least the same reasons provided above with respect to Claim 24. Brocker does not cure the deficiencies of Devarakonda. As such, the combination of Brocker with Devarakonda does not provide all of the elements and limitations of Claim 24 and Claims 30-31, which depend therefrom.

Thus, the rejection of Claims 30-31 under 35 U.S.C. § 103(a) is improper. Applicant respectfully requests withdrawal of the rejection of Claims 30-31 under 35 U.S.C. § 103(a).

#### **IV. Conclusion**

In view of the foregoing and in addition to those presented in Applicant's Appeal Brief, Applicant submits that claim rejections under 35 U.S.C. § 112, first paragraph, 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) are not proper, and Claims 16-20, 24-26 and 30-31 are therefore patentable.

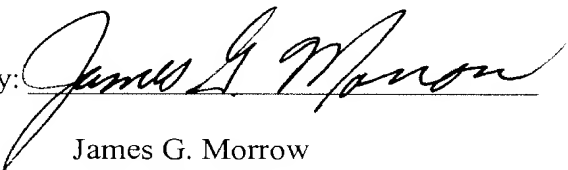
The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16 1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

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Respectfully submitted,

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